

REMARKS

Claims 1-7, 18, and 19 are pending in the application.

I. Support for Claim Amendments

The claims were amended to more clearly define the invention. Claim 1 was amended to recite that the inventive method is directed to decreasing localized inflammatory responses arising from an ischemia/reperfusion injury in a tissue of a human. No new matter is added by this Amendment and entry thereof is respectfully requested.

II. Rejection of claims under 35 U.S.C. § 102(e)/f

Claims 1-7, 18, and 19 stand rejected under 35 U.S.C. § 102(e)/(f) as anticipated by Zimmerman (US 5,997,863). The Board states: “Appellants do not argue that claim 1 differs from the procedure set forth in Example 8 of Zimmerman on the basis of the ‘patient’ being treated” thus concluding that the rabbits treated with heparinase in Example 8 of the Zimmerman patent are patients within the scope of claim 1. (Board Decision, p. 6) Applicants respectfully disagree with the Board’s conclusion that rabbits are patients within the scope of claim 1.

A “patient” is an “individual awaiting or under medical care and treatment.” (Webster’s Ninth New Collegiate Dictionary.) Applicants respectfully submit that one skilled in the medical arts would understand an “individual awaiting or under medical care and treatment” to be a human patient and not a laboratory rabbit, as disclosed in the Zimmerman reference. Nevertheless, Applicants have amended claim 1 to recite a method for decreasing localized inflammatory responses arising from an ischemia/reperfusion injury in a tissue of a human.

Moreover, Applicants acknowledge that the Declarations of Richard Broughton and Israel Vlodavsky filed August 8, 2002, were not considered by the Examiner. Applicants respectfully request reconsideration of the Declarations of Richard Broughton and Israel Vlodavsky (attached in Exhibits A and B, respectively, for the convenience of the Examiner) establishing that they are not the inventors of the presently claimed subject matter and that Bennett and Danagher were the ones who contributed to the subject matter described in Example 8 of the Zimmerman patent.

Applicants further acknowledge the Examiner's statement in the Advisory Action mailed August 30, 2002 (Paper No. 42) that such declarations were not persuasive because "the inventive entity on the instant application also includes inventors that were not listed on the referenced patent and therefore, the referenced patent was done by 'another.'" To this end, Applicants have used their best efforts to locate the four remaining inventors of the instant invention, Cauchon, Fink, Grouix, and Hsia, to establish that they did not, themselves, make an inventive contribution to Example 8 of the Zimmermann patent, which serves as the basis of the this rejection. Despite their best efforts, Applicants were only able to locate one of the four inventors, Elizabeth Cauchon. The executed Declaration of Elizabeth Cauchon is attached as Exhibit C.

Pertaining to the remaining inventors, Applicants respectfully submit herewith an executed Statement of Fact (Exhibit D) by Rita Charles, Intellectual Property Paralegal of BioMarin Pharmaceutical Inc, pertaining to the unavailability of the remaining inventors, Fink, Grouix, or Hsia, despite Applicants' diligent steps to contact them. Specifically, the Statement identifies Applicants' steps to contact the inventors, Fink, Grouix, and Hsia, at their last known

address, the resulting returned undeliverable mail, follow-up communications with IBEX administrators to confirm the last address of these inventors, and again, the resulting returned undeliverable mail. Therefore, despite Applicants' efforts to locate the remaining inventors, Applicants have been unable to locate the remaining inventors.

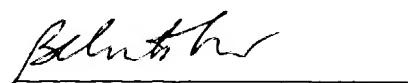
Nevertheless, Applicants respectfully submit that the executed Declaration of Elizabeth Cauchon in combination with the Declarations of Richard Broughton and Israel Vlodavsky attests to the fact that Bennett and Danagher made the inventive contributions to Example 8 of the Zimmermann patent. As such, Applicants respectfully submit that the Zimmermann patent is not by "another."

Because the claims of the instant application are distinguished from the asserted Zimmerman patent and Applicants have provided objective documents confirming that the Example 8 of the Zimmerman patent is not by "another," Applicants respectfully request that the rejection of claims 1-7 and 18-19 under 35 U.S.C. § 102(e)/(f) be withdrawn. In the event that the Examiner disagrees, she is respectfully requested to contact the undersigned to discuss ways to expedite the prosecution of this application.

IV. CONCLUSION

In view of the foregoing remarks, Applicants believe that the application is in condition for allowance.

Respectfully submitted,



Belinda M. Lew
Patent Agent
Reg. No. 53,212

Date: 1/26/04
Hale and Dorr LLP
1455 Pennsylvania Ave., NW
Washington, D.C. 20004
(202) 942-8452